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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,048	11/14/2003	Albert W. Bricker	290201-1010	3194
24504	7590	01/12/2005	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			PECHHOLD, ALEXANDRA K	
		ART UNIT	PAPER NUMBER	
		3671		

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/714,048	BRICKER, ALBERT W.	
Examiner	Art Unit		
Alexandra K Pechhold	3671		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-13 and 31-37 is/are pending in the application.  
4a) Of the above claim(s) 14-30 and 38-63 is/are withdrawn from consideration.

5)  Claim(s) 36 and 37 is/are allowed.

6)  Claim(s) 1-6,8,11-13,31-33 and 35 is/are rejected.

7)  Claim(s) 7,9, 10,34 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date *filed 11/14/03*.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 17-22 and 56-63, drawn to the subcombination of the removable form, classified in class 405, subclass 124.
  - II. Claims 14-16 and 40-55, drawn to the subcombination of the frame rail, classified in class 405, subclass 303.
  - III. Claims 23-30 and 38-39, drawn to the method, classified in class 405, subclass 282.
  - IV. Claims 1-13 and 31-37, drawn to the combination of the trench forming apparatus, classified in class 405, subclass 118.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being used as a form for any type of construction desired. See MPEP § 806.05(d).

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be performed by another apparatus other than that recited.

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be performed by another apparatus other than that recited.

Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be performed by another apparatus other than that recited.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the trench forming apparatus does not require the particulars of the form. The subcombination has separate utility such as a form for constructing another invention.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the trench forming apparatus does not require the particulars of the frame rail. The subcombination has separate utility such as for use as a frame in another type of construction.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with David Risley on January 6, 2005 a provisional election was made with traverse to prosecute the invention of Group IV, claims 1-13 and 31-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-30 and 38-63 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 1-6, 8, 11 and 31-33 are rejected under 35 U.S.C. 102(a) as being anticipated by Gunter (US 2002/0154952 A1).**

Regarding claim 1, Gunter discloses a trench-forming apparatus comprising:

- L-shaped frame rails, seen as members (14) in Fig. 1,
- a removable form, seen as removable form (12) (see [0019]), wherein the form is configured to define an inner trench surface of a completed trench and the frame rails are configured to define top edges of the complete trench as seen in Figs. 1-3.

Regarding claim 2, Fig. 1 illustrates each rail (14) as having a vertical portion and horizontal portion, which are at right angles to each other.

Regarding claim 3, such fixation members can be seen as (42), (30), or (43) in Figs. 1 and 2, which attach to the underside of the rails (14).

Regarding claim 4, lateral grooves adapted to receive the frame rails are seen in Fig. 1 as (38).

Regarding claim 5, Figs. 12-14 of Gunter illustrates cross-rails seen as support attachments (29).

Regarding claim 6, Figs. 13 and 14 illustrate the ties that hold the cross-rails (29) to the rails (14) (see [0056] where Gunter discloses securing wire).

Regarding claim 8, an attachment mechanism on the cross-members can be seen as the securing wires in Figs. 13 and 14 (see [0056] where Gunter discloses securing wire).

Regarding claim 11, an opening in the frame member (14) can be seen in Fig. 2 at the cut-out.

Regarding claim 31, Gunter discloses a trench-forming apparatus comprising:

- L-shaped frame rails, seen as members (14), that have a horizontal portion (see Figs. 1 and 2) for insertion into a removable form, seen as removable elongate form body (12) (see [0019]), and
- a removable form, seen as removable elongate form body (12) (see [0019]), that includes lateral grooves, seen as (38), configured to receive the frame rails,
- wherein the rails are configured to support the form in an excavated trench when the horizontal portions are inserted into the lateral grooves of the form, as seen in Figs. 12-14.

Regarding claim 32, such fixation member can be seen as (42), (30), or (43) in Figs. 1 and 2, which attach to the underside of the rails (14).

Regarding claim 33, Figs. 12-14 of Gunter illustrates cross-rails seen as support attachments (29).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 12, 13, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunter (US 2002/0154952 A1) as applied to claims 1 and 31, respectively above, and further in view of Bricker (US 6,220,784).**

Regarding claims 13 and 35, Gunter fails to disclose an inner core and outer shell. Bricker teaches an inner core (154) and outer shell (156) (Col 4, lines 58-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the form of Gunter to comprise an inner core and outer shell as taught by Bricker, since Bricker states in column 4, lines 58-64 that this shape facilitates easier removal after the hardenable material has been poured in.

Regarding claim 12, Gunter fails to disclose the removable form having a bottom surface that is sloped relative to a top surface. Bricker teaches that it is desirable to have a sloped trench bottom (see Col 4, lines 64-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lack of slope of the bottom of Gunter's form so that there is a slope as taught by Bricker, since Bricker states in column 4, lines 64-67 that such a slope is desirable.

***Allowable Subject Matter***

10. Claims 7, 9, 10, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 36 and 37 are allowed.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.



Thomas B. Will  
Supervisory Patent Examiner  
Group 3600

1/6/05